

REMARKS

Claims 1-4, 6-13, 16-24, 26, 28, and 30-34 were pending in this application. By this amendment, claims 1, 3-4, 6, 13, 24, and 34 are amended and claims 35-36 are new. Claims 11-12, 16, 23, and 31-33 are hereby canceled without prejudice or disclaimer. Thus, claims 1-4, 6-10, 13, 17-22, 24, 26, 28, 30, and 34-36 are now pending in the present application. The claims have not been amended for reasons related to patentability, but are amended to expedite the allowance of this case. Applicants respectfully request reconsideration of the present claims in view of the foregoing amendments and the following remarks.

I. Formal Matters:

Interview Summary Under 37 C.F.R. §1.133

A telephonic interview occurred between Applicants' representative, Michael Lukon and Examiner Joshua Campbell on May 26, 2005. The interview covered the rejection of independent claim 1. The Examiner provided some helpful suggestions on potential claim limitations and stated that an additional search may be necessary. Prior to the conclusion of the interview Applicants' representative proposed amending the claim language and submitting arguments to overcome the cited art.

II. Claim Rejections

A. Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 2, 4, and 34 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publ. No. 2002/0065891 to Malik (hereinafter "Malik"). This rejection is respectfully traversed. Applicants have amended claims 1 and 34.

As amended, claim 1 recites: A method for recognizing the correct spelling of a word associated with an email application, the method comprising: receiving an indication that an email name has been entered into a first field; resolving the email name to a display name, automatically adding the display name to a custom dictionary and at least one module consisting essentially of a spell checker module, auto-completion module, and a smart-tags module if the display name is identified as a new word; receiving an indication that text associated with the display name has been entered into a body of an application; comparing the text associated with the display name to a word list; indicating that the text associated with the display name is

correctly spelled in response to finding a match between the text associated with the display name and the word list; and indicating that the text associated with the display name is incorrectly spelled in response to failing to find a match between the text associated with the display name and the word list.

For a reference to anticipate a claim, the reference must teach each and every claim element recited in the rejected claim. Malik does not teach or suggest each and every element of amended claim 1. For example, Malik does not teach or suggest automatically adding the display name to a custom dictionary and at least one module consisting essentially of a spell checker module, auto-completion module, and a smart-tags module if the display name is identified as a new word. Since Malik does not teach or suggest a method for recognizing the correct spelling of a word as recited by amended claim 1, Malik does not anticipate amended independent claim 1. Since claims 2-4, and 6-10 depend from amended claim 1 and recite additional claim features, Malik does not anticipate claims 2-4, and 6-10. Accordingly, withdrawal of this rejection and allowance of claims 1-4 and 6-10 is respectfully requested.

Amended claim 34 recites: A computer-readable medium having computer executable instructions for performing a method for email messaging, the method comprising: receiving an indication that a first word an email name has been entered; resolving the email name to a display name, determining if the first word display name is a new word; broadcasting a message to at least one application a smart-tags module if the display name is determined to be a new word.

Malik does not teach or suggest each and every element of amended claim 34. For example, Malik does not teach or suggest automatically adding the display name to a smart-tags module if the display name is determined to be a new word. Since Malik does not teach or suggest each element of amended claim 34, Malik does not anticipate amended independent claim 34. Since new claims 35-36 depend from amended claim 34 and recite additional claim features, Malik does not anticipate claims 35-36. Accordingly, withdrawal of this rejection and allowance of claims 34-36 is respectfully requested.

B. Claim Rejections Under 35 U.S.C. §103(a)

Claims 3, 6-11, 13, 16-19, 22, 24, 26, 28, and 31-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malik. Claims 11, 16, and 31-32 are hereby canceled and the rejections thereto are now moot.

The deficient teaching of Malik is discussed above in conjunction with the rejections to independent claims 1 and 34. Malik does not teach or suggest each and every element of amended claim 1. Since claims 3, and 6-10 depend from amended claim 1 and recite additional claim features, Malik does not make obvious claims 3, and 6-10. Accordingly, withdrawal of this rejection and allowance of claims 3, and 6-10 is respectfully requested.

As amended, claim 13 recites: A spell checker for determining whether an entered word is misspelled, comprising: a custom dictionary containing a word list; a message monitor for receiving a broadcast from an e-mail application that a display name is available after resolving an e-mail name; and an automatic word addition module operative to add the display name to the word list and a smart-tags module in response to the message monitor receiving the broadcast from the e-mail application that the display name is available.

Malik does not teach or suggest each and every element of amended claim 13. For example, Malik does not teach or suggest an automatic word addition module operative to add the display name to the word list and a smart-tags module in response to the message monitor receiving the broadcast from the e-mail application that the display name is available. Since Malik does not teach or suggest each and every element of amended claim 13, Malik does not make obvious amended claim 13. Withdrawal of the rejection and allowance of claim 13 is respectfully requested.

Since claims 17-22 depend from amended claim 13 and recite additional claim features, Malik does not make obvious claims 17-22. Accordingly, withdrawal of this rejection and allowance of claims 17-22 is respectfully requested.

Amended claim 24 recites: An email application program for sending and receiving email notes, comprising: an email name resolving module operative to determine a displayed name in response to receiving an entered email name; a new email name reporting module operative to broadcast a new resolved name message to at least one module consisting essentially of a spell checker module, auto-completion module, and a smart-tags module, in response to resolving a new email name associated with the displayed name; and an email name cache for storing the displayed name.

Malik does not teach or suggest each and every element of amended claim 24. Since Malik does not teach or suggest each and every element of amended claim 24, Malik does not make obvious amended claim 24. Since claims 26, 28, and 30 depend from amended claim 24

and recite additional claim features, Malik does not make obvious claims 26, 28, and 30. Accordingly, withdrawal of this rejection and allowance of claims 24, 26, 28, and 30 is respectfully requested.

For the record, in rejecting claims 11, 22, 28, and 32 the Office Action states that “applicant’s disclosed it was well known and thus would have been obvious to one in the art at the time the invention was made that display names could be stored in an address book for an email application for auto-completion purposes.” However, referring to the Background of Applicants’ disclosure, it is clear that Applicants are stating a need for such an application and not admitting that it already exists at the time of Applicants’ invention.

Claims 20-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U.S. Patent No. 5,896, 321 to Miller et al. (hereinafter “Miller”).

As discussed above in conjunction with the rejection to claim 13, Malik does not teach or suggest each and every limitation of amended claim 13. Miller does not compensate for the deficient teaching of Malik. Moreover, Malik and Miller, alone or in combination do not teach or suggest each and every limitation of amended independent claim 13. Thus, the combined teaching of Miller and Malik cannot make obvious Applicants’ claimed invention embodied in amended independent claim 13. Even if the combination of Miller and Malik did make obvious amended claim 13, the Office Action provides no evidence of a suggestion or motivation to combine the references, other than hindsight conclusions based on Applicants’ disclosure. Since claims 20-21 depend from amended claim 13 and recite additional claim features, the combined teaching of Malik and Miller does not make obvious claims 20-21. Accordingly, withdrawal of this rejection and allowance of claims 20-21 is respectfully requested.

Claims 12, 23, 30, and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Malik in view of U.S. Patent No. 5,974,413 to Beauregard et al. (hereinafter “Beauregard”). Applicants believe that the Examiner meant to include Miller in paragraph 11 and the response is based on the application of Miller as well since the paragraphs detailing the rejections recite Miller.

Claims 12, 23, and 33 have been canceled by the present amendment and the rejections thereto are now moot.

Claim 30 depends from amended independent claim 24 and recites additional important features. Miller and Beauregard, alone or in combination, do not remedy the deficient teaching

of Malik with respect to amended independent claim 24. Even if they did, again the Office Action provides no evidence of a suggestion or motivation to combine the three references. Withdrawal of the rejection to claim 30 and allowance is therefore respectfully requested.

CONCLUSION

Applicants assert that the pending claims 1-4, 6-10, 13, 17-22, 24, 26, 28, 30, and 34-36 are in condition for allowance. Applicants further assert that this response addresses each and every point of the Office Action, and respectfully request that the Examiner pass this application with claims 1-4, 6-10, 13, 17-22, 24, 26, 28, 30, and 34-36 to allowance. Should the Examiner have any questions, please contact Applicants' undersigned attorney at 404.954.5040.

Respectfully submitted,

MERCHANT & GOULD, LLC

Date: May 31, 2005



Michael T. Lukon
Reg. No. 48,164

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
404.954.5100

27488

PATENT TRADEMARK OFFICE